

REMARKS

The present application includes claims 1-24. By this Amendment, claims 1, 13, and 23 have been amended. The August 18, 2009 Office Action rejected claims 1, 5, 7-9, 11-13, 15, 19, 21, and 22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,478,802 to Kienzle in view of U.S. Pat. No. 5,743,916 to Greenberg. The Office Action rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Kienzle in view of Greenberg and U.S. Pat. No. 5,269,045 to DeSerio. The Office Action rejected claims 3 and 16 under 35 U.S.C. § 103(a) as being obvious over Kienzle in view of Greenberg and U.S. Pat. No. 5,741,266 to Moran, claims 4 and 17 under 35 U.S.C. § 103(a) as being obvious over Kienzle in view of Greenberg and U.S. Pat. No. 4,788,970 to Karas, claims 6 and 18 under 35 U.S.C. § 103(a) as being obvious over Kienzle in view of Greenberg and U.S. Pat. No. 2,785,384 to Wickesser, and claim 20 under 35 U.S.C. § 103(a) as being obvious over Kienzle in view of Greenberg and U.S. Pat. No. 6,235,038 to Hunter.

The Applicants respectfully traverse the outstanding rejections for the reasons set forth hereafter.

35 U.S.C. § 102 Rejections

Claims 1, 5, 7-9, 11-13, 15, 19, 21, and 22 under 35 U.S.C. § 103(a) were rejected as being unpatentable over Kienzle in view of Greenberg. The Applicants respectfully submit that these claims are not obvious over Kienzle and Greenberg for the reasons set out below.

Kienzle relates to a computer assisted surgery system for accurate positioning of a drill bit into a body part. The system includes a drill guide and a drill with attached localizing emitters whose poses are determined by a localizing device. The drill bit is attached to the drill

and the location of the tip of the drill bit is determined during a calibration step. During drilling, the drill bit is inserted through the bore of the drill guide and the pose of the drill bit is calculated from measured position data of both the drill guide and drill. A graphic representation of the drill bit is then displayed on a monitor screen in an appropriate position relative to stored images or other surgical instruments. Kienzle at Abstract.

Greenberg relates to a drill guide including a sleeve mounted on a handle. The sleeve of the drill guide has a bore which is dimensioned for slidably receiving a bit sizing ferrule therein. The bit sizing ferrule has a sized bore for demountably inserting a drill bit or other instrument therein having a particular width. Greenberg at Abstract.

To establish *prima facie* obviousness of a claimed invention, **all** the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” See MPEP at 2143.03 (emphasis added). Further, “[a]ll words in a claim **must** be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA).” See *id.* (emphasis added).

The Applicants respectfully submit that the combination of Kienzle and Greenberg does not teach or suggest all of the limitations of independent claims 1 and 13. Specifically, neither Kienzle, nor Greenberg, teaches or suggests “a localizer assembly connected to a first collar,” “a handle assembly connected to a second collar,” and the “first and second collars being connected to each other such that said first and second collars move relative to each other and define a central bore” as recited in claim 1 or a “drill guide having a handle assembly connected to a first collar, a localizer assembly connected to a second collar, said first and second collars being connected to each other such that said first and second collars move relative to each other and define a central bore,” as recited in claim 13. While Kienzle may disclose localizing emitters

111 and a handle 104 connected to a bore portion 114, the localizing emitters 111 and handle 104 are not each connected to a collar wherein the collars are connected such that the collars can move relative to each other or define a central bore. Greenberg also fails to teach or suggest this limitation. Therefore, for at least these reasons, the Applicants submit that claims 1, 5, 7-9, 11-13, 15, 19, 21, and 22 are not unpatentable over Kienzle and Greenberg.

Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kienzle in view of Greenberg and DeSerio. The Applicants respectfully submit that the combination of Kienzle, Greenberg, and DeSerio does not teach or suggest all of the limitations of claim 10, and therefore claim 10 is not obvious over Kienzle in view of Greenberg and DeSerio. As discussed above with respect to claim 1, neither Kienzle nor Greenberg teaches or suggests “a localizer assembly connected to a first collar,” “a handle assembly connected to a second collar,” and the “first and second collars being connected to each other such that said first and second collars move relative to each other and define a central bore.” Likewise, DeSerio does not teach or suggest these limitations. Therefore, the Applicants respectfully submit that claim 10, which depends from claim 1, is not unpatentable over Kienzle in view of Greenberg and Moran.

Claims 3 and 16 were rejected under 35 U.S.C. § 103(a) as being obvious over Kienzle in view of Greenberg and Moran. The Applicants respectfully submit that the combination of Kienzle, Greenberg, and Moran does not teach or suggest all of the limitations of independent claims 1 and 13, and therefore claims 3 and 16 are not obvious over Kienzle in view of Greenberg and Moran. As discussed above with respect to claims 1 and 13, neither Kienzle, nor Greenberg, teaches or suggests an “a localizer assembly connected to a first collar,” “a handle assembly connected to a second collar,” and the “first and second collars being connected to each other such that said first and second collars move relative to each other and define a central bore”

as recited in claim 1 or a “drill guide having a handle assembly connected to a first collar, a localizer assembly connected to a second collar, said first and second collars being connected to each other such that said first and second collars move relative to each other and define a central bore,” as recited in claim 13. Likewise, Moran does not teach or suggest these limitations. Therefore, the Applicants respectfully submit that claims 3 and 16 are not unpatentable over Kienzle in view of Greenberg and Moran.

Claims 4 and 17 were rejected under 35 U.S.C. § 103(a) as being obvious over Kienzle in view of Greenberg and Karas. The Applicants respectfully submit that the combination of Kienzle, Greenberg, and Karas does not teach or suggest all of the limitations of independent claims 1 and 13, and therefore claims 4 and 17 are not obvious over Kienzle in view of Greenberg and Karas. As discussed above with respect to claims 1 and 13, neither Kienzle, nor Greenberg, teaches or suggests “a localizer assembly connected to a first collar,” “a handle assembly connected to a second collar,” and the “first and second collars being connected to each other such that said first and second collars move relative to each other and define a central bore” as recited in claim 1 or a “drill guide having a handle assembly connected to a first collar, a localizer assembly connected to a second collar, said first and second collars being connected to each other such that said first and second collars move relative to each other and define a central bore,” as recited in claim 13. Likewise, Karas does not teach or suggest these limitations. Therefore, the Applicants respectfully submit that claims 4 and 17 are not unpatentable over Kienzle in view of Greenberg and Karas.

Claims 6 and 18 were rejected under 35 U.S.C. § 103(a) as being obvious over Kienzle in view of Greenberg and Wickesser. The Applicants respectfully submit that the combination of Kienzle, Greenberg, and Wickesser does not teach or suggest all of the limitations of

independent claims 1 and 13, and therefore claims 6 and 18 are not obvious over Kienzle in view of Greenberg and Wickesser. As discussed above with respect to claims 1 and 13, neither Kienzle, nor Greenberg, teaches or suggests “a localizer assembly connected to a first collar,” “a handle assembly connected to a second collar,” and the “first and second collars being connected to each other such that said first and second collars move relative to each other and define a central bore” as recited in claim 1 or a “drill guide having a handle assembly connected to a first collar, a localizer assembly connected to a second collar, said first and second collars being connected to each other such that said first and second collars move relative to each other and define a central bore,” as recited in claim 13. Likewise, Wickesser does not teach or suggest these limitations. Therefore, for at least these reasons, the Applicants respectfully submit that claims 6 and 18 are not obvious over Kienzle in view of Greenberg and Wickesser.

Claim 20 was rejected under 35 U.S.C. § 103(a) as being obvious over Kienzle in view of Greenberg and Hunter. The Applicants respectfully submit that the combination of Kienzle, Greenberg, and Hunter does not teach or suggest all of the limitations of independent claim 13, and therefore claim 20 is not obvious over Kienzle in view of Greenberg and Hunter. As discussed above with respect to claim 13, neither Kienzle, nor Greenberg, teaches or suggests a “drill guide having a handle assembly connected to a first collar, a localizer assembly connected to a second collar, said first and second collars being connected to each other such that said first and second collars move relative to each other and define a central bore.” Likewise, Hunter does not teach or suggest these limitations. Therefore, the Applicants respectfully submit that claim 20 is not unpatentable over Kienzle in view of Greenberg and Hunter.

For at least these reasons, the Applicants respectfully submit that the pending claims are patentable.

In general, the Office Action makes various statements regarding claims 1-24 and the cited references that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (*e.g.*, if such statements should become relevant by appearing in a rejection of any current or future claim).

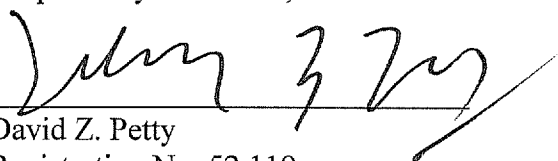
CONCLUSION

The Applicants respectfully submits that pending claims are in condition for allowance.

If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited and encouraged to contact the Applicants' undersigned attorney at (312) 775-8000.

The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account No. 070845 GTC.

Respectfully submitted,



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